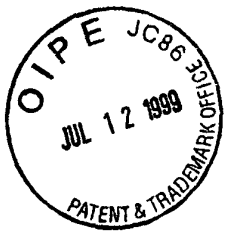
GP1644



PATENT
Attorney Docket No MIV 071.10

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9 Godtfredsen 07/19/99

In re Application of:

David BEACH et al.

Serial No.: 09/016,869

Filed: January 30, 1998

For: *Cell-Cycle Regulatory Proteins, and Uses Related Thereto*

Group Art Unit: 1644

Examiner: M. Tung

CERTIFICATE MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents Washington, D.C. 20231 dated ~~July 2, 1999~~.

July 6, 1999
Date of Signature
and of Mail Deposit

Carmen Parra
Carmen Parra

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement dated June 11, 1999, Applicants provisionally elect with traverse the invention set forth in Group II, claims 11 and 58-76.

In the restriction requirement under 35 U.S.C. § 121, the Examiner alleges that there are two distinct inventions as follows:

I. Claims 1 and 10 are drawn to a CCR protein and immunogen, classified in class 530, subclass 300 and class 514, subclass 12, respectively.

II. Claims 11 and 58-76, drawn to an antibody, classified in class 530, subclasses 387.3 and 387.9.

According to the Examiner, these inventions are distinct and "have acquired a separate status in the art because of their divergent subject matter, fall into different statutory classes of invention, and are separately classified and searched, restriction for examination purposes as indicated is proper." Applicants respectfully traverse this restriction.

The Examiner's attention is directed to M.P.E.P. § 803, which states that:

> If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Thus, for a restriction requirement to be valid, the Examiner must establish the following two criteria:

(1) the existence of independent and distinct inventions (35 U.S.C. § 121); and

(2) that the search and examination of the entire application cannot be made without serious burden (M.P.E.P. § 803).

Applicants respectfully submit that the Examiner has not shown that the second requirement has been met, because, extending the search to include two additional claims would not constitute an undue burden on the Examiner. Therefore, the restriction requirement is in error and the Examiner has not shown that a serious burden would be required to examine the claims of Groups I and II.

In addition, the Examiner states that if Group I is elected, "the applicants is further required to elect a **specific CCR protein**. Applicants, submit that since Group II has been elected for search purposes this election requirement is not applicable.

In point 9, the Examiner states that "claims 11 and 58 are generic". This statement and its relevance is unclear, since, the election requirement is directed to the claims directed to the CCR proteins and not to the antibodies claimed in Group II. In fact, in point 10, the Examiner argues that "the recited proteins have different biochemical characteristics, structure and functions." As stated above, since Group II has been elected provisionally for search purposes, these comments have not been responded to. However, clarification is requested, if the Examiner is requiring a species election of the invention of Group II.

If there are any other fees due in connection with the filing of this response, please charge the fees to our **Deposit Account No. 06-1448**.

Respectfully submitted,
FOLEY, HOAG, & ELIOT

July 6, 1999

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